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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,409	06/07/2001	Bruce M. Ruana	RUANA-002	7700

7590 10/29/2002

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EXAMINER	
GUTMAN, HILARY L	
ART UNIT	PAPER NUMBER
3612	

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/877,409	Applicant(s) Ruana
	Examiner Hilary Gutman	Art Unit 3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Sep 4, 2002*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above, claim(s) *1-14, 30-42, and 57* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *15-29, 43-56, and 58* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *Jun 7, 2001* is/are a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Species B (Figures 3-4, 6, and 8)in Paper No. 8 is acknowledged.

2. Claims 1-14, 30-42, and 57 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "216" (Figure 3).

4. The drawings are objected to because in Figure 7 the lead line for reference number "124" does not appear to be pointing to the axis as indicated by the specification, but instead appears to be pointing to the lengthwise edge which is already represented by reference number 126.

5. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:

On page 2, line 15, "hanging" should perhaps be "hangings".

On page 5, line 3, "tot he" should be "to the".

On page 6, line 4, "FIG. 2" should be "FIG. 3".

On page 8, line 16, "FIG. 2" should be "FIG. 3".

On page 11, the last paragraph (starting on line 16) is repetitive and should be deleted.

On page 12, lines 10-15 appear to be repetitive and confusing. Furthermore, the applicant should stick with either top/bottom surface or inner and outer surface (now stated) but not both. Furthermore, the chosen phrase top/bottom or inner/outer by the applicant should be consistently maintained throughout the specification and claims for clarity. It should be noted that an inner surface and an outer surface are apparently recited in the claims.

On page 13 the first paragraph (lines 1-11) is repetitive and should perhaps be deleted. Also on lines 15, 16, 17, 19, and 20, reference number "130" should be "120" to correspond with the drawing figures.

On page 14, line 1, "130" should be "120" to correspond with the drawings.

Appropriate correction is required.

7. The use of the trademarks Flexicon (pages 7, 8, and 9) and mylar (page 7) has been noted in this application. These trademarks should be capitalized wherever they appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

8. The abstract of the disclosure is objected to because: on line 4, "beams. The wrap-" should be "beams". On line 5, "around advertising surface" should be deleted.

Correction is required. See MPEP § 608.01(b).

Claim Objections

9. The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Specifically, in claim 58, line 5, "grip 6" is recited with no parentheses.

10. Claims 21 and 49 are objected to because of the following informalities: on line 2, "elastimer" is thought to be misspelled and should perhaps instead be "elastomer".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 15-29, 43-56, and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, it is unclear how the stretchable layer is able to "stretch" while being permanently adhered to the backing layer, which may not "stretch".

Claim 23 recites the limitation "its length" in line 2. There is insufficient antecedent basis for this limitation in the claim.

For claims 25-28, the phrases "sublimation printing", "heat pressure transfer process", "wet ink printing", and "digital graphics" are all considered processes making these claims product-by-process claims. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim(s) is the same as or obvious from a product of the prior art, the claim(s) are unpatentable even though the prior product was made by a different process (MPEP 2113).

In claim 29, line 2, "mylar" is recited which is improper since this phrase is considered a trademark and should not be included in the claims. Instead the generic terminology should be used.

Claim 43 recites the limitation "a railing" in line 3. There is insufficient antecedent basis for this limitation in the claim. Also in claim 43, it is unclear how the stretchable layer is able to "stretch" while being permanently adhered to the backing layer, which may not "stretch".

Claim 50 recites the limitation "its length" in line 2. There is insufficient antecedent basis for this limitation in the claim.

For claims 52-55, the phrases "sublimation printing", "heat pressure transfer process", "wet ink printing", and "digital graphics" are all considered processes making these claims product-by-process claims. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim(s) is the same as or obvious from a product of the prior art, the claim(s) are unpatentable even though the prior product was made by a different process (MPEP 2113).

In claim 56, line 2, "mylar" is recited which is improper since this phrase is considered a trademark and should not be included in the claims. Instead the generic terminology should be used.

Claim 58 recites a method "of claim 24" in the preamble but later recites "of claim 6" in the body of the claim (at line 6) which is improper. The dependency of the claim should be stated

in the preamble only and not in the body of the claim and furthermore, the claim should perhaps only be dependent upon one of these claims.

Claim 58 recites the limitation "its length" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Allowable Subject Matter

13. Claims 15-29, 43-56, and 58 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references show other advertising systems and railings similar to that of the current invention.

15. Any inquiry concerning this communication from the examiner should be directed to Hilary L. Gutman whose telephone number is (703) 305-0496.

16. **Any response to this action should be mailed to:**

Assistant Commissioner for Patents
Washington, D.C. 20231

or faxed to:

(703) 305-3597, (for formal communications intended for entry)

or:

(703) 305-0285, (for informal or draft communications, please clearly label "PROPOSED" or "DRAFT").

hlg
10/21/02

D. GLENN DAYOAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

10/21/02